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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/775,115

02/01/2001

Johnny B. Corvin

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ROPES & GRAY LLP

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EXAMINER

SHEPARD, JUSTIN E

ART UNIT

PAPER NUMBER

2623

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DELIVERY MODE

01/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/775,115		CORVIN, JOHNNY B.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Justin E. Shepard		2623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 December 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14-16, 40-48 and 69-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-16, 40-48 and 69-80 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 12/18/07 have been fully considered but they are not persuasive.

Page 3, paragraph beginning with "First, the Examiner":

The applicant argues that Mori teaches a "CD reproduction device" that cannot be combined with the forced advertisement system disclosed by Zigmond. As Mori teaches a device for playing video-cds (see machine translation) that can resume playback after a loss of power, and Zigmond discloses a device for playing back advertisement from a storage device (column 10, lines 16-35), the combination of these references is valid as the storage medium from Zigmond could easily be a video-cd.

Page 4, section A:

The applicant argues that Aoyama could not be combined with Zigmond. As the rejection is formed such that Aoyama is being used to modify Mori and not directly modifying Zigmond, this argument is moot.

Page 4, section B:

The applicant argues that Aoyama cannot be combined with Mori. As Mori describes a device to reproduce a piece of media after a power outage, and Aoyama teaches a device that reproduces a piece of media (or advertisement) after an interruption (playing of a karaoke song); it would make sense to combine the

references, as Aoyama teaches that a commercial is usually short so that it loses all meaning if the viewer only views a portion of it, so there is motivation to combine.

Page 5, section C:

The applicant argues that the combination of Zigmond, Mori, and Aoyama would not result in the claimed invention. As Zigmond discloses a device to force users to view an advertisement that has been stored locally on the device, and Mori teaches a system for resuming video after a power failure such as a commercial, and finally Aoyama teaches replaying an advertisement after an interruption (such as the playing of a song). There way the examiner is interpreting the references, the combination would result in the claimed invention.

Page 7, paragraph beginning with "As set forth":

The applicant argues that the combination of Zigmond and Russo would result in the destruction of the Zigmond reference. As Zigmond discloses a system wherein targeted ads are sent and stored on the user's set top box, wherein Russo teaches a PPV system wherein user selected videos are stored on the user's set top box. In a way, a targeted ad is like a user selected video, and storing the place where it was interrupted for replaying at another time is common to both references, but using different methods. Therefore modifying the Zigmond reference with the teachings of Russo is a valid combination.

Page 8, section IV:

The examiner has included machine translations of the two references in question. Upon browsing the references, the translations back up the interpretations of the abstracts by the examiner.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 14, 16 and 40, 42, 43, 45, 46, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Mori in view of Aoyama.

Referring to claim 14, Zigmond discloses a method of presenting a forced advertisement to a television viewer, the method comprising:

detecting the forced advertisement in an incoming video stream;  
presenting the forced advertisement on user equipment (column 7, lines 2-32).

Zigmond does not disclose a method with the step of turning off the user equipment while the forced advertisement is being displayed; and automatically presenting the forced advertisement, when the user equipment is turned on, from the beginning of the forced advertisement.

In an analogous art, Mori teaches a method with the step of turning off the user equipment while the forced advertisement is being displayed; and automatically

presenting the forced advertisement, when the user equipment is turned on (Abstract: Solution; Note: as the ads disclosed by Zigmond are downloaded onto the STB (figure 6, part 106), the device taught by Mori is considered to be analogous art as it deals with resuming playback of data from a storage medium after a power failure).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the resuming after a power loss taught by Mori to the system disclosed by Zigmond. The motivation would have been to enable the device to present an entire program even after a power loss had occurred, therefore allowing the broadcaster to guarantee that an ad would be played on the STB regardless of the user's actions.

Zigmond and More do not disclose a method wherein the ad is played from the beginning of the forced advertisement.

In an analogous art, Aoyama teaches a method wherein the ad is played from the beginning of the forced advertisement (Abstract: Solution).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the replay from the beginning method taught by Aoyama to the method disclosed by Zigmond and Mori. The motivation would have been that playing an advertisement in its entirety would allow for better viewer retention over showing only the last few seconds.

Claims 40, 43, and 46 are rejected on the same grounds as claim 14.

Referring to claim 16, Zigmond discloses a method of claim 14, wherein the forced advertisement is stored in the user equipment (figure 6, part 106).

Claims 42, 45, and 48 are rejected on the same grounds as claim 16.

2. Claims 15, 41, 44, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Mori in view of Aoyama as applied to the claims above, and further in view of Hite.

Referring to claim 14, Zigmond, Mori and Aoyama do not disclose a method of claim 14, further comprising preventing the television viewer from changing channels while the forced advertisement is being presented.

In an analogous art, Hite teaches a method of claim 14, further comprising preventing the television viewer from changing channels while the forced advertisement is being presented (column 11, lines 58-60).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the channel changing suppression taught by Hite to the method disclosed by Zigmond, Mori and Aoyama. The motivation would have been to stop aggressive channel surfers from avoiding the commercials (Zigmond: column 13, lines 16-39).

Claims 41, 44, and 47 are rejected on the same grounds as claim 15.

3. Claims 69, 71, 72, 74, 75, 77, 78, and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Russo in view of Mori.

Referring to claim 69, Zigmond discloses a method of presenting a forced advertisement, the method comprising: detecting the forced advertisement in an

incoming video stream; presenting the forced advertisement on user equipment (column 7, lines 2-32).

Zigmond does not disclose a method with the steps of turning off the user equipment while the forced advertisement is being displayed; and automatically presenting the forced advertisement, when the user equipment is turned on, from the point at which the user equipment was turned off.

In an analogous art, Russo teaches a method with the steps of interrupting the user equipment while the forced advertisement is being displayed; and automatically presenting the forced advertisement, when the user equipment is uninterrupted, from the point at which the user equipment was interrupted (column 5, lines 14-19).

At the time of the invention it would have been obvious for one of ordinary skill in the art to use the video resuming taught by Russo in the system disclosed by Zigmond. The motivation would have been to allow the user to have the ability to watch a program or commercial from the point when their watching was interrupted from a network outage, thereby allowing for the advertiser to be assured that their advertisement was aired.

Zigmond and Russo do not disclose a system where the interruption is caused by a power loss.

Mori discloses a system where the interruption is caused by a power loss (Abstract: Solution).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the resuming after a power loss taught by Mori to the system disclosed by



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Zigmond. The motivation would have been to enable the device to present an entire program even after a power loss had occurred, therefore allowing the broadcaster to guarantee that an ad would be played on the STB regardless of the user's actions.

Claims 72, 75, and 78 are rejected on the same grounds as claim 69.

Claims 71, 74, 77, and 80 are rejected on the same grounds as claim 16.

4. Claims 70, 73, 76, and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Russo in view of Mori as applied to the claims above, and further in view of Hite.

Referring to claim 70, Zigmond, Russo and Mori do not disclose a method of claim 69, further comprising preventing the television viewer from changing channels while the forced advertisement is being presented.

In an analogous art, Hite teaches a method of claim 69, further comprising preventing the television viewer from changing channels while the forced advertisement is being presented (column 11, lines 58-60).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the channel changing suppression taught by Hite to the method disclosed by Zigmond, Mori and Aoyama. The motivation would have been to stop aggressive channel surfers from avoiding the commercials (Zigmond: column 13, lines 16-39).

Claims 73, 76, and 79 are rejected on the same grounds as claim 70.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

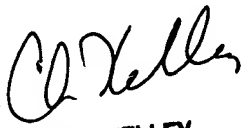
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin E. Shepard whose telephone number is (571) 272-5967. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JS

  
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